



FACSIMILE TRANSMISSION

TO: Felicity Groth

FAX NUMBER: 215-568-3439

Re: Application Serial Number 08/837009

Attorney File Reference: CHIRON 0054

FROM: Lorraine Spector, Primary Examiner, Art Unit 1647

U.S. Patent and Trademark Office

Telephone: (703) 308-1793

FAX: (703) 746-5228

NUMBER OF PAGES TRANSMITTED, INCLUDING COVER: 5

MESSAGE: Attached is the courtesy copy of the Office Action to be mailed today or tomorrow. Please feel free to call if you have any questions.



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 1/28/02

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-49 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-10, 12-14, 18, 20, 22, 27, 28, 49 is/are allowed.
- ☒ Claim(s) 15, 16, 17, 19, 21, 23-26, 29-48 is/are rejected.
- ☒ Claim(s) 11 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Part III: Detailed Office Action

Finality in this application is **WITHDRAWN**.

New rejections and objections apply.

Formal Matters:

5 The specification is objected to because applicants have not filed drawings (copies or original) that are in compliance with 37 C.F.R. § 1.84 in this reissue application. Applicants are notified that the Patent Office no longer transfers drawings from the patent file in a reissue proceedings. See MPEP 1413. Correction is required.

10 Claim 11 is objected to under 37 C.F.R. § 1.173(b)(2) as being improperly amended; "(b)" should not be underlined. Correction is required.

A large volume of art was cited in the patent of which this is a reissue. Applicants are requested to make that art of record in this case, using a form PTO-1449.

15

Objections and Rejections under 35 U.S.C. §112:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20 Claims 15-17, 19, 21, 23-26, 29-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15-17, 19 and 21 are indefinite because claim 8, from which they depend, uses the plural "cellular hosts", whereas claims 15-17, 19 and 21 limit said hosts in the singular only.

25 ✓
✗
○
✓
Claims 23-24, 31 and 46 are indefinite for reciting "an amino acid sequence...". Such would seem to imply that there is more than one sequence in each figure; it is not clear whether the sequences of the figures must be present in their entirety, or whether the claim might include portions thereof, e.g. without the signal sequence. Claim 46 is further indefinite as it is not clear how

many fragments might comprise the polypeptide, nor what the minimum size of said fragments might be. It is noted that without recitation of a minimum size, the claims could be construed to read on a fragment encoding as little as a dipeptide.

✓
5 Claims 44 and 46 are improperly dependent upon claim 1, which is drawn to a composition, and not to a nucleic acid (compound).

The remaining claims are rejected for depending from an indefinite claim.

✓
10 Claims 27-28 are indefinite as claims 4 and 5, from which they depend, are drawn to compositions, and not to nucleic acids.

Advisory Information:

Claims 1-10, 12-14, 18, 20, 22, 27, 28 and 49 are allowable.

Claim 11 is objected to.

15 Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,405,942 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

20 Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

25 Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

Serial Number 08/837009
Art Unit 1647

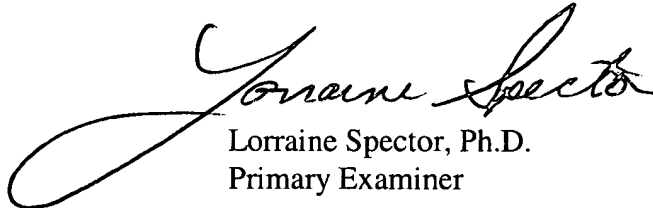
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Lorraine M. Spector, whose telephone number is (703) 308-1793. Dr. Spector can normally be reached Monday through Friday, 9:00 A.M. to 5:30 P.M.

5 If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Gary L. Kunz, at (703)308-4623.

10 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at telephone number (703) 308-0196.

15 Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Official papers filed by fax should be directed to (703) 872-9306 (before final rejection) or (703)872-9307 (after final). Faxed draft or informal communications with the examiner should be directed to (703) 746-5228.

20 
Lorraine Spector, Ph.D.
Primary Examiner

25 LMS
08/837009
10/22/02

*** TX REPORT ***

TRANSMISSION OK

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